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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/174,598 10/19/98 JEANNIN

P XI/P03139US2

EXAMINER

000881 HM12/0310
LARSON AND TAYLOR
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA VA 22314

ART UNIT PAPER NUMBER

1617

DATE MAILED: 03/10/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10/19/98 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-38, 40, 42-52 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 39, 41 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-38, 40, 42-52 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received.
It has been filed in parent application, serial no. 09/106,302; filed on 5/27/97.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Receipt is acknowledged of the amendment of 10/19/98. Applicant is requested to submit any relevant prior art of which she is aware.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, 12-14, 21-30, 32-35, 48-52 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Only the particular compounds "A" is shown effective as claimed - one of ordinary skill in the art would need to do an excessive amount of experimentation in order to determine effectiveness when used as a collar on a pet, for 6 months or more, without toxicity to the pet, of compounds other than "A" of formula 1.

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Claims 1-38, 40, 42-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner fails to find "R₃" at the diagram of formula (I) any place in the specification and claims. Examiner requests applicant to review especially claims, for spelling and other inconsistencies. In claim 1, "such as" is indefinite - please spell out acceptable hetero atoms supported in the specification. Note the R₃ is referred to twice at each in dependent claim, and, for example at claims 7, 8, 10, 11 -. Note that claim 43 recites the long lasting; but, there is none in claims 31, 22, or 21 - this is claim is thus out of synch with claims 44-46, but clearly comprehensible.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-38, 40, 42-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Buntain et al. EP - 0295117.

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The instant compounds (pages 2-4) as external (p. 7) devices, protect pets from fleas and ticks (p. 4) at the instant applied PVC collar concentration (example 12). Inherently, these application methods of these compounds would meet the instant requirements for efficacy, since the same compound(s) applied the same way to the same pets are shown.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim(38)40, 42-52 rejected under 35 U.S.C. 103(a) as being unpatentable over Buntain et al. - EP 0295117 in view of admission in the specification.

The instant compounds (page 2-4) are effective against the instant fleas and ticks applied on Pets (page 4 as ear tags and collars (page 7, lines 11-14) to achieve local control and systemic control (See example 12). Concentration is .5-25%, in a PVC collar, utility in the instant claim 11 compound. As to the functions and methods, the prior art cited shows the collars as presented in the instant

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specification. The instant claims recite ensuring 6 months efficacy, as per a test, but this is shown (p. 5, pages 10-12) that one of ordinary skill in the art has at his disposal references to making the collar, and the collar materials and concentrations thereof determine the duration and efficacy.

Thus, it would be obvious to one of ordinary skill in the art desiring to utilize flea/tick pet collars admittedly known in the art, to utilize them with Buntain's invention, in order to kill fleas/ticks, as application would result in.

Further, no criticality, or objective showing of nonobvious or unexpected results is seen by the applicant to distinguish over the prior art.

There is no unusual and/or unexpected results obtained since the prior art is well aware of the use of the compounds and binders in the instant devices.

It has not clearly been established by a showing of some additional unusual and/or expected results that the administration of the particular ingredients provide any greater level of prior art expectation as claimed. The selection of an ingredient for the use for which it is known is not a basis for patentability.

All the critical elements of the instant invention are disclosed.

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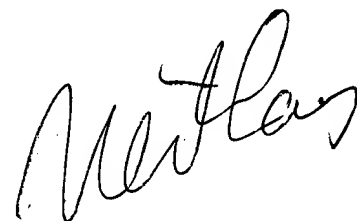
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Neil Levy, whose telephone number is (703) 308-2412. The examiner can normally be reached on Monday, Tuesday through Thursday and Friday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Adams, Ph.D., JD., can be reached on (703) 308-0570. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

LEVY; aco

March 5, 1999



NEIL S. LEVY
ER

NEIL S. LEVY
PRIMARY EXAMINER